

10/764,088MS164190.03/MSFTP209USB**REMARKS**

Claims 1-22 are currently pending in the subject application and are presently under consideration. Claims 1, 12, 14, 17 and 20 have been amended. In addition, the specification has been amended to correct a typographical error.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-22 Under 35 U.S.C. §102(e)

Claims 1-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ford, *et al.* (US Patent 6,510,424). Withdrawal of this rejection is requested for at least the following reasons. Ford *et al.* does not disclose each and every limitation of the claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Claim 1 recites the limitation control parameters generated at least in part utilizing a *statistical model to infer uncertainties about contextual information*; and determining whether to send a notification and/or a communication at least in part by *considering whether the value of sending exceeds the cost of sending* the notification and/or communication, the cost based at least in part on the contextual information. Claims 14 and 20 recite similar limitations. Claim 17 recites the limitation a notification manager that employs a *decision-theoretic analysis* to determine whether to selectively send a communication, the decision-theoretic analysis based at least in part upon one or more *parameters relating to at least the value and the cost of sending the communication*, the cost determined at least in part by evaluating a user's context, the decision-theoretic analysis comprising *inferring at least one user context parameter value based on a likelihood*. Ford *et al.* does not disclose these novel features of the subject claims. Accordingly, for at least the foregoing reasons, applicants' representative respectfully requests

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withdrawal of this rejection and allowance of the subject claims.

II. Rejection of Claims 17-19 Under 35 U.S.C. §103(a)

Claims 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ford, *et al.* (US Patent 6,510,424) in view of Park, *et al.*, "An Adaptive Agent-Based Framework for Knowledge Management and Sharing," pp. 1-7. Withdrawal of this rejection is requested for at least the following reasons. The Examiner has not made an adequate showing that Park *et al.* is prior art to the subject application and, in addition, the cited references do not render obvious the claimed subject matter as a whole.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also* e.g., *In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (*See In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (*See Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (*See In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *see also In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of

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coming forward with evidence or argument shift to the applicant. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

The copy of the Park *et al.* reference supplied by the Examiner does not indicate when this document or the information contained therein became publicly available. In the Office Action, the Examiner indicates that the date of the Park *et al.* reference is 1999. (See Office Action dated May 5, 2005 at p. 15). However, the Park *et al.* reference cites to other references dated as late as 2000 and indicates that it is a “[w]orking paper last revised April 2001.” (Park *et al.* at p. 1; *see also* Park *et al.* at pp. 5-7). The copy of the Park *et al.* reference provided by the Examiner provides no evidence that the document or the information contained therein was publicly available prior to the January 25, 2001 priority date of the subject application. Thus, the Examiner has not made an adequate showing that the Park *et al.* reference is prior art to the subject patent application.

Moreover, as discussed *supra*, Ford *et al.* does not disclose each and every limitation of claim 17. Park *et al.* does not remedy this deficiency. Accordingly, for at least the foregoing reasons, applicants' representative respectfully requests withdrawal of this rejection and allowance of the subject claims.

10/764,088MS164190.03/MSFTP209USB**CONCLUSION**

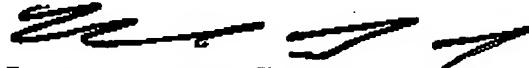
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP209USB].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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